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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/313,120	05/17/99	KATZ	R 241/184

EXAMINER

WOO, S

ART UNIT

PAPER NUMBER

2743

DATE MAILED:

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LM02/1028

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/313,120

Applicant(s)

Katz

Examiner

Stella Woo

Group Art Unit
2743



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 17-22 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 17-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 17-22 are rejected under the judicially created doctrine of double patenting over claim 23 of U. S. Patent No. 5,128,984 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Claim 17

A telephone call processing system...
comprising:
means for selectively receiving
calls from said multitude of terminals
to establish telephone communication

Claim 23

A telephone call processing system...
comprising:
means for selectively receiving
calls from said multitude of terminals
to establish telephone communication

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with a select subset of callers,

means for providing...,

means for individually cuing...,

means for storing...

with a select subset of callers,

means for providing...,

means for individually cuing...for processing,

means for storing...

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

See also MPEP § 804.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Entenmann et al. (USPN 4,996,705, hereinafter "Entenmann").

Regarding claim 19, Entenmann discloses a telephone call processing system comprising:
means for receiving calls (eligible callers are identified via online responses in the form of a valid credit card number; Abstract, lines 4-5; col. 2, lines 63-67) utilizing automatic identification signals (customer telephone number is forwarded using ANI ; col. 2, lines 54-56);

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means for providing identification signals (ANI signals supplied by the local switching system; col. 2, lines 5-11);

means for individually cuing (announcement system 17; col. 3, lines 9-11);

means for processing data (lottery entries are processed to isolate winners; col. 3, lines 34+);

means for storing (database 19).

Regarding claim 20, Entenmann provides for randomly generating a lottery number (col. 3, lines 35-43).

Regarding claims 21-22, Entenmann provides for a plurality of different lotteries including a customer paid lottery or a sponsor paid lottery (col. 2, lines 47-62).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Entenmann et al. (Entenmann) in view of the reference entitled "The AT&T Multi-Mode Voice Systems - Full Spectrum Solutions for Speech Processing Applications" by Hester et al. (Hester).

Entenmann discloses a telephone call processing system comprising:

means for selectively receiving calls (eligible callers from a certain locale are identified via calling number signals; col. 2, lines 54-62);

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means for providing identification signals (ANI signals supplied by the local switching system; col. 2, lines 5-11);

means for individually cueing (announcement system 17 prompts eligible callers to provide a lottery selection via DTMF or speech entry; col. 3, lines 8-20);

means for storing (database 19).

Although Entenmann provides for a plurality of lotteries (plurality of formats) being controlled by the same system (col. 2, lines 47-48), it differs from claims 17-18 in that it does not specify the use of DNIS for selecting from the plurality of formats. However, Hester teaches the well known use of DNIS for access to a plurality of formats (page 3, second paragraph) such that it would have been obvious to an artisan of ordinary skill to incorporate the use of DNIS, as taught by Hester, within the lottery system of Entenmann in order to automatically identify the selected lottery format from a plurality of lottery formats using DNIS.

Regarding claim 18, Entenmann provides for randomly generating a lottery number (col. 3, lines 35-43).

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Scanlon shows a lottery system which receives ANI information and prompts for a PIN code before allowing participation in the lottery. Reese and Scott et al. show other telephone lottery systems.

8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

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Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

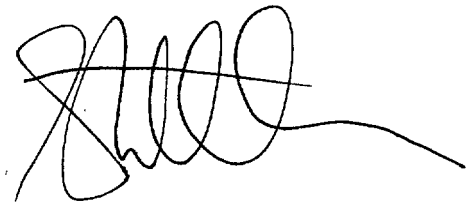
Or:

(703) 305-9508, (for informal or draft communications, please label
"PROPOSED" or "DRAFT").

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stella Woo whose telephone number is (703) 305-4395 and can normally be reached from 6:30 a.m. until 2:00 p.m. on Monday, Wednesday, Friday, and from 6:30 a.m. until 10:30 a.m. on Tuesday and Thursday.

October 28, 1999



**STELLA WOO
PRIMARY EXAMINER**